

REMARKS

The 35 USC 101 Rejection of Claims 1-9.

The Office Action rejected claims 1-9 under 35 U.S.C. 101 as being directed to non-statutory subject matter. The applicants respectfully traverse this rejection based on the arguments below.

If a claimed mathematical algorithm or computer program produces a "useful, concrete, and tangible result" it cannot be rejected on the grounds of being non-statutory under 35 U.S.C. 101. AT&T Corp. v. Excel Communications, Inc., Docket No. 98-1338, (Fed. Cir. April 14, 1999). State Street Bank & Trust Co. v. Signature Financial Group, Inc., 149 F. 3d 1368 (Fed. Cir. 1998). The applicants' claims include comparing a buyer's profile and the inferred criteria with the criteria of the products or services offered by agents to match a suitable agent with a suitable buyer based on the created profile of the buyer in a computer system that produces a **practical application** within the technological arts to find a prospective buyer and providing the identity of the buyer to agents. Therefore, the Applicants' invention includes a well-established practical application that satisfies the requirement of 35 USC 101. State Street Bank & Trust Co. v. Signature Financial Group, Inc., 149 F. 3d 1368 (Fed. Cir. 1998). Arrhythmia Research Technology Inc. v. Corazonix Corp., 958 F.2d 1053, 22 USPQ2d 1033 (Fed. Cir. 1992). *MPEP* 706.03 et seq.

Furthermore, the USPTO's own guide on software related patent applications (Examination Guidelines for Computer-Related Inventions Final Version) available on its website, states,

“A process that consists solely of the manipulation of an abstract idea without any limitation to a practical application is non-statutory.¹ **Office personnel have the burden to establish a *prima facie* case that the claimed invention taken as a whole is directed to the manipulation of abstract ideas without a practical application....**In order to determine whether the claim is limited to a practical application of an abstract idea, **Office personnel must analyze the claim as a whole, in light of the specification, to understand what subject matter is being manipulated and how it is being manipulated. During this procedure, Office personnel must evaluate any statements of intended use or field of use, any data gathering step and any post-manipulation activity.** See section IV.B.2(d) above for how to treat various types of claim language. **Only when the claim is devoid of any limitation to a practical application in the technological arts should it be rejected under § 101. Further, when such a rejection is made, Office personnel must expressly state how the language of the claims has been interpreted to support the rejection.”**

Clearly, when viewing the claim as a whole, Claim 1 is not devoid of any limitation in a practical application in the technological arts. The applicants' claims include comparing a buyer's profile and the inferred criteria with the criteria of the products or services offered by agents to match a suitable agent with a suitable buyer based on the created profile of the buyer in a computer system that produces a **practical application** within the technological arts to find a prospective buyer and providing the identity of the buyer to agents.

Furthermore, the Examiner cites that “For example in claim 1, the invention in the body of the claim does not recite the use nor incorporate any technology in carrying out the recited method steps and therefore is not necessary.” As per the USPTO own

¹ *E.g., Warmerdam*, 33 F.3d at 1360, 31 USPQ2d at 1759. See also *Schrader*, 22 F.3d at 295, 30 USPQ2d at 1459.

guidelines on the examination of software-related inventions, in order to determine whether the claim is limited to a practical application of an abstract idea, **Office personnel must analyze the claim as a whole**, in light of the specification, to understand what subject matter is being manipulated and how it is being manipulated. **...Only when the claim is devoid of any limitation to a practical application in the technological arts should it be rejected under § 101. Further, when such a rejection is made, Office personnel must expressly state how the language of the claims has been interpreted to support the rejection.** Clearly, as discussed above, comparing a buyer's profile and the inferred criteria with the criteria of the products or services offered by agents **to match a suitable agent with a suitable buyer based on the created profile of the buyer** is a practical application. Clearly, Claim 1 does not meet the USPTO's own definition of what is non-statutory subject matter:

"In practical terms, claims define non-statutory processes if they:

- consist solely of mathematical operations without some claimed practical application (*i.e.*, executing a "mathematical algorithm"); or
- simply manipulate abstract ideas, *e.g.*, a bid² or a bubble hierarchy,³ without some claimed practical application."

In response to the Applicants arguments the Office Action states that the test is:

"1-Does the method provide a useful, tangible and concrete results?

2-Does the claimed method steps in the body of claim recite and incorporate technology to carry out the recited steps?"

Furthermore, the Examiner contends that the "test" is not based upon whether the claim has application in the technological arts but rather whether technology is used

² *Schrader*, 22 F.3d at 293-94, 30 USPQ2d at 1458-59.

³ *Warmerdam*, 33 F.3d at 1360, 31 USPQ2d at 1759.

to carry out the recited steps in this business method application for patent.

However, the applicant has reviewed the MPEP and can find no mention of the above test. The only test mentioned in the MPEP with this subject is the above test for non-statutory subject matter cited by the applicant. The applicants respectfully request to know in which reference the Examiner's test can be found. The preamble of Claim 1 clearly states "A **computer implemented method** for finding a prospective buyer and providing the identity of the buyer to agents offering for sale at least one of products or services, the method **comprising using a computer to perform the following process actions...**" so clearly technology is used to carry out the recited steps, even though the applicant cannot find this interpretation in the guidance either.

Furthermore, the MPEP states in Section 2106, that "**When a computer program is claimed in a process where the computer is executing the computer program's instructions, Office personnel should treat the claim as a process claim.**" In 2106 paragraph IV.B.2(b) the MPEP cites an example, "...a computer that recognizes a particular grouping of musical notes read from memory and upon recognizing that particular sequence, causes another defined series of notes to be played, defines a functional interrelationship among that data and the computing processes performed when utilizing that data, and as such is statutory because it implements a statutory process." This example would appear to be similar to the applicants claimed invention and hence the applicants contend Claim 1 is statutory.

Therefore, the Applicants' invention includes a well-established practical application that satisfies the requirement of 35 USC 101. It is therefore respectfully requested that the rejection of 1-9 under 35 USC 101 be reconsidered based on the foregoing arguments.

The 35 USC 103 Rejection of Claims 1-27.

Claims 1-27 were rejected under 35 USC 103(a) as being unpatentable over Raveis, Jr., U.S. Patent No. 6,321,202, in view of Burge, U.S. Patent No. 6,014,638, in further view of Rizzo, U.S. Patent No. 6,470,338. The Examiner contended that it would have been obvious to combine Raveis with the system and method of Burge to enable the ability for the computer implemented method and system to create a profile of the buyer by inferring criteria desired by the buyer based on the buyer's interaction with the interactive environment and to compare the profile and the inferred criteria to the products and services offered by agents to match a suitable agent with a suitable buyer based on a created profile of the buyer. However, the Examiner further contended that the Raveis and Burge combination does not specifically disclose providing the identity of the suitable buyer to the agent, but that Rizzo does. The applicants respectfully traverse this contention of obviousness.

The applicants' claimed invention, as amended, encompasses a system and method for finding a prospective buyer and providing the buyer to agents offering for sale products or services. The applicant's claimed invention provides the buyer with an interactive environment having information relating to the products or services offered by the agents. A profile of the buyer is created by inferring criteria desired by the buyer based on the buyer's interaction with the interactive environment. The profile and the inferred criteria are compared with the criteria of the products or services offered by the agents to match a suitable agent with a suitable buyer based on the created inferred profile of the buyer. The identity of the suitable buyer is automatically provided to the suitable agent without required action from the agent.

Raveis teaches a system and method for managing real estate transactions. The method includes the steps of receiving and storing data relating to a plurality of contacts including buyers and sellers of real estate, receiving and storing data relating to a plurality of vendors each associated with at least one phase of a real estate transaction,

accessing vendor data based upon occurrence of a particular phase of the real estate transaction and communicating data relating to the vendors to a contact upon occurrence of the particular phase of the real estate transaction. **As stated by the Examiner, Raveis, does not, however, disclose and teach a computer-implemented method and system which creates a profile of the buyer by inferring criteria desired by the buyer based on the buyer's interaction with the interactive environment and compares a buyer's profile and inferred criteria with the criteria of the products or services offered by the agents to match a suitable agent with a suitable buyer based on the created profile of the buyer. Nor does Raveis teach providing the identity of the suitable buyer to the suitable agent.**

Burge teaches a system for customizing content and presentation of content for computer users is disclosed. The system monitors and records a user's navigational choices to determine the user's needs and preferences for subsequent computer displays. Displays are customized in accordance with the user's needs and preferences. In a preferred embodiment of the present invention, an electronic marketing and shopping system accessible via the WWW is described. The shopping environment—including the opportunities presented to the shopper (content) and the appearance of the displays (presentation of content)—is customized according to the shopper's preferences. The functions of data collection and display customization are performed automatically by the electronic shopping system. To customize the environment, various attributes of Web pages or other displays provided by participating merchants are modified as they are accessed by shoppers using the system. (Abstract)

Burge merely displays certain items to the buyer based on the buyer's past preferences. No seller's criteria are used to match a buyer to a seller and provide the seller the buyer's identity. Burge does not provide the identity of a suitable buyer to a suitable agent. In Burge it is impossible for the seller to obtain the buyer's identity.

Rizzo teaches a computerized method for matching potential clients with professional services providers which meet their personalized criteria and are interested in providing particular services to them including the steps of: presenting a first electronic document including a plurality of data entry devices to the potential clients via a computer network; receiving data entered using the data entry devices, the received data being indicative of the criteria established by the client; automatically comparing the received data to data stored in a storage medium to identify one or more suitable professional services providers; automatically generating and transmitting via the computerized network an electronic mail message to the identified one or more service providers, **the electronic message including information indicative of a portion of the received data; and, receiving a response from at least one responding one of the one or more identified service providers, and automatically providing information indicative of another portion of the received data to the responding one of the service providers.**

Rizzo's system is set up for a client in need of attorney services. Hence, when the data entered by the client is sent out to one or more suitable attorneys only part of the client's information is provided. The client's identity is not provided (Figure 1B, step 270). In order to retrieve the client's identity the attorney must manually go to a website and request to retrieve it (Figure 1B, step 290). **Clearly, Rizzo does not automatically provide the client's identity to the attorney without the need for the attorney to perform manual actions.**

In order to deem the applicants' claimed invention unpatentable under 35 USC 103, a prima facie showing of obviousness must be made. To make a prima facie showing of obviousness, all of the claimed elements of an applicant's invention must be considered, especially when they are missing from the prior art. If a claimed element is not taught in the prior art and has advantages not appreciated by the prior art, then no prima facie case of obviousness exists. The Federal Circuit court has stated that it was error not to distinguish claims over a combination of prior art references where a material limitation in

the claimed system and its purpose was not taught therein (*In Re Fine*, 837 F.2d 107, 5 USPQ2d 1596 (Fed. Cir. 1988)).

Rizzo does not teach automatically providing the identity of a buyer to a suitable agent without the agent having to take action. Nor does Rizzo recognize the advantages thereof, such a reduced effort for the agent. Hence, no prima facie case of obviousness has been established.

In view of the lack of a prima facie case of obviousness, the remaining rejected Claims 1-27 cannot be deemed to be unpatentable under 35 USC 103 over Burge and Raveis in view of Rizzo. As such, it is respectfully requested that the rejection of Claims 1-27 be reconsidered based on the following claim language, as exemplified by Claim 1:

" A computer implemented method for finding a prospective buyer and providing the identity of the buyer to agents offering for sale at least one of products or services, the method comprising using a computer to perform the following process actions...providing the buyer with an interactive environment having information relating to the products or services offered by the agents; creating a profile of the buyer by inferring criteria desired by the buyer based on the buyer's interaction with the interactive environment; comparing the profile and the inferred criteria with criteria of the products or services offered by the agents to match a suitable agent with a suitable buyer based on the created profile of the buyer; **and automatically providing the identity of the suitable buyer to the suitable agent without action from the agent.**"

Furthermore, it is the applicants' position that there is no motivation to modify the Raveis or Burge teachings with those of Rizzo because such a combination would destroy the stated function of the Burge invention.

Burge teaches a system for customizing content and presentation of content for

computer users. The system monitors and records a user's navigational choices to determine the user's needs and preferences for subsequent computer displays. The functions of data collection and display customization are performed automatically by the electronic shopping system. In Rizzo the data collection functions are manual as the user specifies the desired criteria and they are not inferred. Therefore, in order to combine Rizzo with Burge the automated function of the Burge invention would be destroyed by the substitution of manual actions required by Rizzo for matching a buyer to seller. Furthermore, in Rizzo the buyer specifically specifies the criteria for the seller.

It is well settled in the law that a 35 USC 103 rejection based on a modification of prior art that destroys the function of the invention disclosed in the prior art, is improper and does not establish a prima facie case of obviousness. *In Re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). There is simply no technological motivation for a worker to make such a detrimental modification. To the contrary, a significant disincentive exists. In this case, the proposed substitution of Rizzo's inferring the buyer's criteria instead of the buyer specifying their criteria would destroy the functionality of the Raveis and Burge inventions and so a prima facie case of obviousness cannot be established from the cited references.

In view of the lack of a prima facie case of obviousness, the rejected Claims 1-27 cannot be deemed to be unpatentable under 35 USC 103 over Burge and Raveis in view of Rizzo. As such, it is respectfully requested that the rejection of Claims 1-27 be reconsidered based on the above-quoted claim language.

Summary.

In summary, it is noted that the Applicant initiated Interview never took place. The applicant respectfully requests that such an interview take place before any further Office Actions are issued. It is believed that the claims are in condition for allowance.

Reconsideration of the rejection of Claims 1-27 is respectfully requested and allowance of these claims at an early date is also courteously solicited.

Respectfully submitted,



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